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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,842	01/29/2004	Adam L. Cohen	06530.0320	2337

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EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/765,842

Applicant(s)

COHEN ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-24 and 26-92 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-46,87 and 88 is/are allowed.  
6) ☒ Claim(s) 47,50-57,60-67,70-77,80-86 and 89-92 is/are rejected.  
7) ☒ Claim(s) 48,49,58,59,68,69,78 and 79 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/13/05, 5/27/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Notice of Amendment***

In response to the amendment filed on May 13, 2005, cancelled claims 2 and 25; amended claims 1, 3, 13, 26-27 and 36; and new claims 47-92 are acknowledged. The objection to the drawings is *withdrawn*. The rejection of claims 1-46 under 35 USC § 102(b) is *withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 67, 70-77, 80-86 and 91-92 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,920,953 to McGown.

**In regards to claims 67, 70-73, 77 and 81-83** McGown discloses an endoscope cap comprising: a first accommodating portion 16 having a first configuration corresponding to an interface of a first endoscope; and a second accommodating portion 18 having a second configuration corresponding to an interface of a second endoscope, the first configuration being different than the second configuration (see Col. 3, Lines 1-10). The main body 10 includes a first flange 32 and a second flange to aid in retaining an interface of a first and second endoscope, respectively (see Col. 3, Lines 30-34). Furthermore, McGown discloses an endoscope cap wherein the first accommodating portion is on a first side of the endoscope channel cap and the second

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accommodating portion is on a second side of the endoscope channel cap (see Fig. 1 and Col. 3, Lines 1-17).

**In regards to claims 74-75, 84-85**, McGown discloses an endoscope cap further comprising at least one seal 20 to prevent fluid communication therethrough and is configured to accommodate an endoscopic instrument therethrough wherein the cap is capable of receiving the endoscopic instrument from either end of the seal (see Col. 3, Lines 18-34). Furthermore, the seal is configured to conform to an outer geometry of the endoscopic instrument extending therethrough and is normally closed (see Col. 1, Lines 30-55).

**In regards to claims 76, 86**, McGown discloses an endoscope cap wherein the seal includes two seals 20 and 56 each configured to accommodate the endoscopic instrument therethrough (see Col. 3, Line 66 – Col. 4, Line 8).

**In regards to claims 91-92**, McGown discloses an endoscope cap wherein at least one seal of the at least two seals is not in flow communication with one of the first accommodating portion and the second accommodating port (see Fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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• Claims 47, 50-57, 60-66 and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,920,953 to McGown in view of U.S. Patent No. 6,117,070 to Akiba.

**In regards to claims 47, 53-54, 57, 63-64,** McGown discloses an endoscope cap comprising: a first accommodating portion 16 having a first configuration corresponding to an interface of a first endoscope; and a second accommodating portion 18 having a second configuration corresponding to an interface of a second endoscope, the first configuration being different than the second configuration (see Col. 3, Lines 1-10). The main body 10 includes a first flange 32 and a second flange to aid in retaining an interface of a first and second endoscope, respectively (see Col. 3, Lines 30-34). Furthermore, McGown discloses an endoscope cap wherein the seal includes two seals 20 and 56 each configured to accommodate the endoscopic instrument therethrough (see Col. 3, Line 66 – Col. 4, Line 8) but is silent with respect to at least two seals being fixedly positioned relative to each other. Akiba teaches of an analogous plug device having first and second passage portions 28 and 29 located on the plug to substantially block communication with the atmosphere of the instrument or to constrict the flow passage area. The diameter of each passage can be equal or smaller than a treating instrument (see Col. 8, Lines 1-35). It would have been obvious to one skilled in the art at the time the invention was made to include at least two fixed seals in the apparatus of McGown to provide a plug which can securely prevent outflow of contaminant fluids through an entrance passage of the endoscopic instrument channel and which can minimize the pressure difference between the endoscopic

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instrument channel and an entrance passage to the endoscopic instrument channel as taught by Akiba.

**In regards to claims 50-52, 60-62,** McGown discloses an endoscope cap wherein the first accommodating portion is on a first side of the endoscope channel cap and the second accommodating portion is on a second side of the endoscope channel cap (see Fig. 1 and Col. 3, Lines 1-17).

**In regards to claims 55-56, 65-66,** McGown discloses an endoscope cap further comprising at least one seal 20 to prevent fluid communication therethrough and is configured to accommodate an endoscopic instrument therethrough wherein the cap is capable of receiving the endoscopic instrument from either end of the seal (see Col. 3, Lines 18-34). Furthermore, the seal is configured to conform to an outer geometry of the endoscopic instrument extending therethrough and is normally closed (see Col. 1, Lines 30-55).

**In regards to claims 89-90,** McGown discloses an endoscope cap wherein at least one seal of the at least two seals is not in flow communication with one of the first accommodating portion and the second accommodating port (see Fig. 1).

***Allowable Subject Matter***

Claim 1-46 are allowed.

Claims 48-49, 58-59, 68-69 and 78-79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments, see amendment, filed May 13, 2005, with respect to amended claims 1 and 24 have been fully considered and are persuasive. The rejection of claims 1-46 under 35 USC § 102(b) has been *withdrawn*.

Applicant's arguments with respect to claims 47 and 57 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed May 13, 2005 with regards to claims 67 and 77 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the accommodating portions receiving an endoscope from the *same side* of the cap) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

6/30/05

*MJK*

*B. M. Flanagan*  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER